

REMARKS

Reconsideration of the application is respectfully requested.

Claims 1-40 have been rejected. No claims have been amended or cancelled. All amendments are fully supported by the original disclosure. No new matter has been introduced. Accordingly, Claims 1-40 remain pending in the application.

Applicant appreciatively acknowledges the Examiner's withdrawal of the finality of the previous Office Action and the Examiner's consideration of Applicant's arguments submitted in the Appeal Brief.

Finality of the Office Action

"Under present practice, second or any subsequent actions on the merits shall be final, **except where the examiner introduces a new ground of rejection** that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p)." MPEP 706.07(a) (emphasis added). In the Final Office Action mailed July 12, 2007, Examiner has introduced new rejections not necessitated by amendments to claims or based on an IDS filing under the circumstances described. Finality of the Office Action is premature and is therefore improper. Applicant respectfully requests that Examiner withdraw the finality of the Office Action.

Rejections under 35 U.S.C. § 112, first paragraph

Claims 1, 7, 15, 21, 27 and 35 were rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In particular, the Examiner rejected the limitation "without usage of said source application" as unsupported by the specification.

Claim 27 does not include the limitation “without usage of said source application” and is therefore in condition for allowance under 35 U.S.C. § 112, first paragraph. Claims 28-34 depend from claims 27 and are also in condition for allowance under 35 U.S.C. § 112, first paragraph.

“The Examiner has the initial burden, after a thorough reading and evaluation of the content of the application, of presenting *evidence or reasons* why a person skilled in art would not recognize that the written description of the claimed invention is present in the specification as filed. . . .” MPEP 2163. The Examiner has stated that the phrase “without usage of said source application” is unsupported. Applicant respectfully disagrees.

The element of claim 1 cited by the Examiner recites: “generating by the computing device a *self-contained representation* of the one or more user interface displays including one or more specifications correspondingly specifying the one or more user interface displays, *to enable viewing of said contents of said binary file without usage of said source application*, by rendering said one or more user interface displays in accordance with said one or more specifications.” The term “self-contained representation” is defined in the specification as “all binary files/representations not having a dependency beyond typical system services and generic utilities such as a browser.” (Pg. 9, lines 3-6) The specification teaches that while a self-contained representation will have some dependency on a basic operating system service, “the dependency does not extend to specific applications such as Word, Excel, WordPerfect, and so forth.” (Pg. 9, lines 8-15) The purpose of the method described by Applicant is to generate a self-contained representation of a binary file that can be viewed by a recipient regardless of whether the recipient has installed the application used to create the binary file (see Fig. 2). A person with ordinary skill in the art will readily understand from the specification and figures that Applicant’s method enables viewing of the contents of a binary file without usage of the source application. Reconsideration of this rejection is, therefore, respectfully requested.

Independent claims 7, 15, 21 and 35 were rejected on the same basis. Dependent claims 2-6, 8-14, 16-20, 22-26 and 36-40 were also rejected on the basis of their dependence from claims 1, 7, 15, 21 or 35. For the reasons stated above, Applicant submits that all claims are in condition for allowance under 35 U.S.C. § 112, first paragraph, and respectfully requests reconsideration of this rejection.

Rejections under 35 U.S.C. § 112, second paragraph

Claims 1-40 were rejected under § 112, second paragraph. Specifically, the Examiner rejected the claims for use of a negative limitation (“without usage of said source application”) that rendered the claim indefinite because it was an attempt to claim the invention by excluding what the inventors did not invent rather than distinctly and particularly pointing out what they did invent. Applicant respectfully disagrees.

As previously discussed, independent claim 27 and its dependent claims 28-34 do not include the limitation “without usage of said source application.” Reconsideration of this rejection as it applies to those claims is respectfully requested.

“The **current** view of the courts is that there is **nothing inherently ambiguous or uncertain about a negative limitation**. So long as the boundaries of the patent protection sought are set forth definitely, albeit negatively, the claim complies with the requirements of 35 U.S.C. 112, second paragraph. Some **older** cases were critical of negative limitations because they tended to define the invention in terms of what it was not, rather than pointing out the invention. Thus, the court observed that the limitation “R is an alkenyl radical other than 2-butenyl and 2,4-pentadienyl” was a negative limitation that rendered the claim indefinite *because it was an attempt to claim the invention by excluding what the inventors did not invent rather than distinctly and particularly pointing out what they did invent. In re Schechter*, 205 F.2d 185, 98 USPQ 144 (CCPA 1953); MPEP 2173.05(i).”

The language quoted by the Examiner from *In re Schechter* addressed a limitation used to carve out an exception (two chemicals previously described) from the broad category of chemicals claimed as the invention. In contrast, Applicant's claim limitation "without usage of said source application" is used to distinctly and particularly point out the subject matter of the claims. Applicant's invention generates a self-contained representation of a binary file that can be viewed by a recipient regardless of whether the recipient has installed the application used to create the binary file, and the limitation "without usage of said source application" clarifies the subject matter that is claimed. Independent claims 1, 7, 15, 21 and 35 are therefore respectfully submitted to be in condition for allowance under 35 U.S.C. § 112, second paragraph.

Dependent claims 2-6, 8-14, 16-20, 22-26 and 36-40 were also rejected on the basis of their dependence from claims 1, 7, 15, 21 or 35. For the reasons stated above, Applicant submits that all claims are in condition for allowance under 35 U.S.C. § 112, second paragraph, and respectfully requests reconsideration of this rejection.

Rejections under 35 U.S.C. § 102

In the Office Action, the Examiner rejected claims 1-3, 6-7, 9-14, 21-23, 26-27, and 29-34 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,178,432 to Cook et al ("*Cook*"). Applicant respectfully requests reconsideration of this rejection for at least the following reasons.

Claim 1 currently recites, in part, the features "processing by a computing device a binary file generated by a source application to identify one or more user interface displays rendered when contents of the binary file are viewed using the source application" and "generating by the computing device a self-contained representation of the one or more user interface displays including one or more specifications correspondingly specifying the one or more user interface displays, to enable viewing of said contents of said binary file without usage of said source application, by rendering

said one or more user interface displays in accordance with said one or more specifications.”

Cook does not teach identifying “one or more user interface displays rendered when contents of the binary file are viewed using the source application” or “generating by the computing device a self-contained representation of the one or more user interface displays”. At best, *Cook* teaches a method for creating an interactive web page that includes objects and structures. In the *Cook* method, a Java applet manages the display of the objects and user interaction with the objects on the web page. *Cook* does not teach the processing of a binary file by a computing device *to identify one or more user interface displays rendered when contents of the binary file are viewed using the source application* as recited in claim 1, but merely teaches a method for interactively displaying objects placed on the website by the web page creator. *Cook* recites converting documents into objects suitable for display on the website but does not disclose a method for the conversion. There is no disclosure that the conversion process includes identifying user interface displays rendered when the binary file is viewed using the source application. Thus, *Cook* does not teach this element of claim 1.

Further, *Cook* does not teach “generating a self-contained representation of the one or more user interface displays”. Instead, *Cook* only teaches converting a file to an object that may be placed on a website. There is no disclosure that the object is a representation of one or more user interface displays – for example, the object may present the same text as the original but without other visual aspects of the user interface display.

Applicant respectfully submits that claim 1 is patentable over *Cook*. Independent claims 7, 21 and 27 have features similar to those of claim 1 and are therefore also in condition for allowance over *Cook*. Claims 2-3 and 6, 9-14, 22-23, 26, and 29-34

depend from claims 1, 7, 21 and 27, respectively, and are patentable over Cook for at least the same reasons.

Rejections under 35 U.S.C. § 102(e)

In the Office Action, the Examiner rejected claims 1-3, 6-7, 9-14, 21-23, 26-27, and 29-34 under 35 U.S.C. § 102(3) as being anticipated by U.S. Patent No. 6,272,484 to Martin et al. ("*Martin*"). Applicant respectfully requests reconsideration of this rejection for at least the following reasons.

Claim 1 currently recites, in part, the features "processing by a computing device a binary file generated by a source application to identify one or more user interface displays rendered when contents of the binary file are viewed using the source application" and "generating by the computing device a self-contained representation of the one or more user interface displays including one or more specifications correspondingly specifying the one or more user interface displays, to enable viewing of said contents of said binary file without usage of said source application, by rendering said one or more user interface displays in accordance with said one or more specifications."

Martin does not teach identifying "one or more user interface displays rendered when contents of the binary file are viewed using the source application" or "generating by the computing device a self-contained representation of the one or more user interface displays". At best, *Martin* teaches a method for capturing a visual image from a web page or other electronic document and storing the image in a second location. In the *Martin* method, an electronic document is accessed locally or over the internet, an image of at least part of the document is captured and saved in another location, and both the image and the original document are linked to a thumbnail of the image. The user can then access either the original document or the image by selecting the thumbnail. *Martin* teaches that the user displays "**at least a portion** of the electric document" before capturing the displayed image (see col. 10, lines 35-46, 56-59; see

also Fig. 7 and Fig. 8). Thus, *Martin* does not teach “generating by the computing device a self-contained representation of one or more user interface displays” because an image captured by this method does not necessarily represent a user interface display as it appears using the source application.

Martin also does not teach the processing of a binary file by a computing device “to identify one or more user interface displays rendered when contents of the binary file are viewed using the source application as recited in claim 1”. There is no disclosure that the image capture process includes identifying user interface displays rendered when the binary file is viewed using the source application, or that the “contents of said binary file” are viewable “without usage of said source application”. . Instead, *Martin* merely teaches capturing an image of at least a portion of the document displayed.

Applicant respectfully submits that claim 1 is patentable over *Martin*. Independent claims 7, 15, 21, 27 and 35 have features similar to those of claim 1 and are therefore also in condition for allowance over *Cook*. All claims depending from claims 1, 7, 15, 21, 27 and 35 are patentable over *Martin* for at least the same reasons.

Rejections under 35 U.S.C. § 103(a)

In the Office Action, the Examiner rejected claims 4-5, 8, 15-20, 24-25, 28, and 35-40 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,178,432 to Cook et al (“*Cook*”) in view of what was well known in the art. Applicant respectfully requests reconsideration of this rejection for at least the following reasons.

Claims 4-5 depend from claim 1 and incorporate its limitations. As previously discussed, *Cook* does not teach “generating by the computing device a self-contained representation of the one or more user interface displays” as recited in claim 1. What was well known in the art cannot remedy the deficiencies of *Cook*. Claims 4-5 are therefore patentable over *Cook* in view of what was well known in the art.

Claims 24 and 25 parallel claims 4 and 5, respectively, and are also patentable over *Cook* in view of what was well known in the art.

Similarly, claim 8 incorporates the limitations of claim 7, which recites “processing by the computing device the binary file to generate a self-contained representation of user interface displays of said binary file rendered when contents of the binary file are viewed using the source application.” *Cook* does not teach this element of claim 7, and what was well known in the art cannot remedy the deficiencies of *Cook*. Claim 8 is therefore patentable over *Cook* in view of what was well known in the art.

Claim 28 parallels claim 8 and is also patentable over *Cook* in view of what was well known in the art.

Claim 15 recites, in part, the elements “determining by the computing device whether said first attachment type is associated with a member of a group of one or more supported source applications”, “selecting by the computing device a set of one or more user interface display specifications from a plurality of sets of one or more user interface display specifications”, “launching by the computing device a locally accessible version of the associated source application”, “capturing by the computing device output responses of the associated source application to said one or more user input signals”, and “associating the captured output responses with the selected set of user interface display specifications to generate a self-contained representation of said first attachment to allow subsequent viewing of the attachment without further use of the associated source application.”

Cook does not teach “determining by the computing device whether said first attachment type is associated with a member of a group of one or more supported source applications” or “launching by the computer device a locally accessible version of the associated source application.” *Cook* discloses that documents associated with an

interactive web page may be stored and distributed by a web server. These associated files include “objects and structures and their behaviors, and a Java applet which is used to display the objects based on the occurrence of certain events” (see col. 6, lines 24-29). *Cook* does not disclose determining the source application associated with an e-mail attachment or launching a locally accessible version of the associated source application. Instead, a Java applet is used to manage the display of the objects. Thus, *Cook* does not teach these elements of claim 15.

Cook also does not teach “selecting by the computing device a set of one or more user interface display specifications from a plurality of sets of one or more user interface display specifications.” *Cook* recites converting documents into objects suitable for display on the website but does not disclose a method for the conversion. There is no disclosure that the conversion process includes identifying user interface displays rendered when the binary file is viewed using the source application. Thus, *Cook* does not teach this element of claim 15.

Further, *Cook* does not teach “associating the captured output responses with the selected set of user interface display specifications” or “a self-contained representation of said first attachment”. Instead, *Cook* only teaches converting a file to an object that may be placed on a website. There is no disclosure that the object is a representation of one or more user interface displays. The object may present the same text as the original but without other visual aspects of the user interface display. *Cook* does not teach identifying user interface displays rendered when the binary file is viewed using the source application, as discussed above. Therefore, *Cook* does not teach all elements of claim 15.

What was well known in the art cannot remedy the deficiencies of *Cook* with respect to the elements of claim 15. Applicant respectfully submits that claim 15 is in condition for allowance and request reconsideration of this rejection.

Claims 16-20 depend from claim 15 and are therefore patentable over Cook in view of what was well known in the art. Claims 35-40 recite similar limitations and are also patentable over Cook in view of what was well known in the art. Applicant respectfully requests reconsideration of these rejections.

CONCLUSION

Applicant submits all pending claims are in condition for allowance. Issuance of the Notice of Allowance is respectfully requested.

Please charge any shortages and credit any overages to Deposit Account No. 500393.

Respectfully submitted,
SCHWABE, WILLIAMSON & WYATT, P.C.

Dated: September 10, 2007

/Robert C. Peck/
Robert Peck
Registration No. 56,826

Pacwest Center, Suite 1900
1211 SW Fifth Avenue
Portland, Oregon 97204
Telephone: 503-796-2099